

REMARKS

Claims 1-12 and 14-32 are pending in the application.

In response to a final Office Action dated September 10, 2003, the applicant filed an RCE on October 31, 2003. The Examiner has now made an Election/Restriction requirement. The requirement at this time is inappropriate, and the applicant respectfully traverses for the following reasons.

First, pursuant to 37 CFR 1.142 and MPEP Sections 802 and 811, a restriction requirement may only be made *prior* to a final action. In this case, the Examiner issued a final action on September 10, 2003. Thus, the Examiner had issued a final action, and a restriction requirement at this late date is in clear contravention to the code and the MPEP and therefore must be rescinded.

Second, MPEP Section 811 entitled "Time for Making Requirement" states that the Examiner "should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement *develops*." Thus, MPEP Section 811 suggests that a restriction requirement may be made after an action on the merits only when it becomes proper; i.e., the applicant has caused the application to change such that a restriction requirement has become proper. In this case, nothing has transpired to cause a new restriction requirement to become proper. The applicant has not amended the claims other than to more clearly define certain

aspects of the claims. Nothing has occurred to define or distinguish the fracture fixation pin from the fracture fixation pin system at this late stage. In fact, the minor amendments to the claims relating to both the fixation pin (claims 1-15, 18-20 and 23-30) and the system (claims 16, 17, 21, 22, 31 and 32) are all directed to the fixation pin; none of the amendments to the system claims are directed to the driver member or mill tool. *The filing of an RCE does not give the Examiner permission to do what was improper prior to the filing thereof.* Nothing has developed to cause restriction at this time. The applicant, by filing the RCE, has simply paid to continue prosecution on the merits. Thus, the Examiner is unfairly and improperly adding significant burden and expense to the applicant and is ignoring the plain language of the MPEP. The applicant respectfully requests that the Examiner provide the basis for ignoring the clear mandate of the MPEP in making this restriction requirement even though nothing has transpired to cause the need for it to "develop".

Third, under MPEP Section 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Clearly, there is no serious burden in the present case, as all claims have already been searched by the Examiner and multiple actions of the merits have already occurred (with respect to both identified inventions). Furthermore, it is noted that any search of the claimed system would be incomplete if limited to 604/104 (screw/pin placement/removal means), and would also need to include the pin itself in 604/73 (threaded orthopedic fastener). That is, the searches for the pin and the system are not discrete, but overlap.

Finally, it is noted that it would have been appreciated if the Examiner would have attempted to reach the attorney for applicant by telephone in accord with recommended restriction practice under MPEP Section 812.01. Such would have given the attorney for applicant an opportunity to explain to the Examiner by telephone why restriction at this time is inappropriate without causing the applicant to incur the significant expense associated with a written response. In addition, telephone restriction practice under MPEP 812.01 permits prosecution to proceed expeditiously.

It is not understood why the Examiner has chosen to delay action on the merits at this late point in the prosecution. Nevertheless, it is respectfully requested that the Examiner withdraw the Election/Restriction requirement, and proceed to such examination, and that prompt allowance be provided. Should any issues remain outstanding, the Examiner is requested to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,



David S. Jacobson  
Reg. No. 39,235  
Attorney for Applicant(s)

GORDON & JACOBSON, P.C.  
65 Woods End Road  
Stamford, CT 06905  
(203) 329-1160

January 20, 2004